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IN THE
Supreme Court of the United States
OCTOBER TERM, 1970

No. 338

BLONDER-TONGUE LABORATORIES, INC.
Petitioner,

v.

UNIVERSITY OF ILLINOIS FOUNDATION, et al.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

BRIEF FOR THE AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

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BRIEF FOR THE AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

I. AUTHORITY TO FILE

This brief is filed by the American Patent Law Association (APLA) as *amicus curiae* and is presented to the Court under Rule 42(2). The letters of consent from petitioner and respondents are on file with the clerk of the Court.

II. PURPOSES OF BRIEF

The purposes of this brief are to:

1. Urge that this Court's interpretation in *Graham, Calmar* and *Adams* (the *Trilogy*[1]) of the nonobviousness test of 35

[1]Graham v. John Deere Co., 383 U.S. 1 (1966); Calmar, Inc. and Colgate-Palmolive Co. v. Cook Chem. Co., 383 U.S. 1 (1966); and United States v. Adams, 383 U.S. 39 (1966).

U.S.C. 103 be the sole and exclusive basis for determining the patentability of new contributions to the useful arts.[1a]

2. Point out that since the *Trilogy* was decided in 1966, the United States Courts of Appeals have split over the meaning of the *Trilogy's* criteria for nonobviousness in two different and inconsistent ways to establish two incompatible patent systems in the United States.

3. Urge that this Court reaffirm its criteria for nonobviousness by clarifying the language it used in *Anderson's-Black Rock*[2] to the extent that implications therein suggest that a different standard, a test of "invention", survives the passage of the Patent Act of 1952.

4. Put in perspective the relitigation question and point out some important policy reasons for this Court to back up the lower Federal courts in sustaining the rules of *Triplett v. Lowell.*[2a]

Petitioner Blonder-Tongue presents five questions for consideration by the Court, some of which are further subdivided. This *amicus* brief deals only with the nonobviousness condition of patentability which is involved in petitioner's questions 3 and 5, and the relitigation issue posed in petitioner's question 1. This limitation on the scope of the present *amicus* brief is imposed because APLA believes that the other questions do not present the broad policy issues raised by the two questions to which this brief is directed.

[1a]The Patent Act of 1952 enacted as Title 35 of the United States Code requires that an invention to be patentable must satisfy the three conditions of patentability set forth in Sections 101, 102 and 103, i.e., the invention must be new, useful and unobvious. See Commr. Patents v. Deutsche Gold-und-Silber-Scheideanstalt Vormals Roessler, 397 F.2d 656 (D.C. Cir. 1968).

[2]Anderson's–Black Rock v. Pavement Salvage Co., 396 U.S. 57 (1969).

[2a]297 U.S. 638 (1936).

III. INTEREST OF THE AMERICAN PATENT LAW ASSOCIATION

The American Patent Law Association is an association of approximately 3,900 members of the bars of many states interested in the patent system and the administration and interpretation of the laws relating to patents. Over one-half of the patent lawyers in the United States are members of APLA and the nature of their practice and the types of clients they represent cover the entire spectrum. Some members are in private practice while others are employed by corporations and the government. Some represent individuals while others represent small research and development companies and large corporations. Nearly all of them sometimes represent parties seeking to uphold patents and at other times parties seeking to invalidate patents.

Since the members of the Association are sometimes on one and sometimes on the other side of the various issues now before the Court, the Association's sole interest in this *amicus* brief is to explain to the Court why it is concerned about the issues it proposes to discuss, how they are related to the proper functioning of the patent system and what adverse effects are to be expected if the issues are not dealt with properly.

IV. 35 U.S.C. 103 AS INTERPRETED BY THE TRILOGY - THE SOLE TEST OF PATENTABILITY

A. The Split Among the Circuits After The *Trilogy*

Since the Court of Appeals for the Seventh Circuit in its adjudication of validity below properly looked to the *Trilogy* and its explication of the patentability test established by 35 U.S.C. 103 and ignored the "invention" test with or without the synergism to which *Black Rock* makes reference, the Court may well ask why the APLA bothers to appear herein as *amicus curiae* at all. The reason is that the same Isbell patent had been held invalid by the Court of Appeals

for the Eighth Circuit in *University of Illinois Foundation v. Winegard Co.*[3] and that court also looked to the *Trilogy* as the basis for its holding.

This split is only one instance of the dichotomy that has developed in this country on how the nonobviousness criteria enunciated in the *Trilogy* are to be applied and what their practical purpose really is. Comprehensive statistical and substantive compilations and analyses lead to the necessary conclusion that the various U.S. Courts of Appeals are using more than one set of legal standards. Thus, the Seventh and Fifth Circuits' holding 45.6% and 51.8% of its adjudicated patents to be valid after the *Trilogy* is strikingly different from the Eighth and Ninth Circuits' holding of 0.0% and 16.3%, respectively.[4] Statistical analysis suggests what substantive analysis by students of the subject has demonstrated, namely that the *Trilogy* has resulted in a statistically significant split among the federal appellate courts on what nonobviousness means under the law.

Amicus believes the Seventh Circuit correctly construed and the Eighth Circuit misconstrued the nonobviousness criteria of the *Trilogy*. Unfortunately, *Anderson's - Black Rock* used language which has seemingly approved both of these conflicting views at the same time.

It is of transcendent importance to the continued vitality of the Patent System that the proper test for the third condition of patentability be chosen and correctly applied to the resolution of the factual issues presented herein by petitioner and respondents.

If the proper test to be applied is clarified now, patent owners, businessmen and potential infringers can order their business activities to accord with whatever threshold level

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[3]402 F.2d 125 (1968), *cert. denied*, 394 U.S. 917 (1969).

[4]See Kayton, *The Crisis of Law in Patents*, Pt. I, 5 & Appendix 2, 13-14 (Patent Resources Group, Wash., D.C. (1970)).

of patentability this Court and Congress agree upon.[5] Whatever the level, the parties will be able to predict with some degree of accuracy what test a lower court will select to determine the validity of patents which come before them.

This Court has rightly condemned the "nose of wax."[6] approach to claim interpretation. Its application to the test for patentability should be no less repugnant to the development of a uniform and reasonably predictable body of law on the nature and application of the proper standard for patentability.[7]

B. Section 103 and the Patent Act of 1952

Even though an invention is new and useful, Section 103 provides that

> "A patent may not be obtained . . . if the differences between the subject matter sought to be patented

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[5]One aspect of the problem which is *not* going to be discussed in this *amicus* brief is whether the standard of patentability is being applied too strictly or too loosely. Whether the courts were (or are) too strict or too lax in deciding questions of validity, whether the Patent Office applied (or applies) too low a standard in issuing patents, whether the Patent Act of 1952 dictated a relaxation of the level of patentability and whether this Court was correct in holding that, as to the level of patentability, the 1952 Act was a codification of prior law have been hotly debated. As much as these controversies interest and affect *amicus* and its members, they are not germane to the position APLA takes in this brief.

If the courts are currently applying Section 103 too restrictively as some have suggested, then Congress will no doubt clarify its intent through further legislation. Indeed, legislation looking toward this end is presently before the Congress (S.2756, 91st Cong., 1st Session (1969). *Amicus Curiae* limits its discussion herein to the nature of the test prescribed by 35 U.S.C. 103 and the deficiencies of the "invention" test it was designed to replace.

[6]White v. Dunbar, 119 U.S. 47, 51-52 (1886).

[7]Since a great deal of the discussion herein relates to conditions for patentability under the 1952 Act, the conflicting requirements for "invention" and the *Black Rock* decision, for the convenience of the court three pertinent articles on the subject are included in the separate Appendix.

> and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."[8]

Two points emerge from a review of the Patent Act of 1952 in general and Section 103 in particular. First, the plain language of Section 103 makes it quite clear that Congress intended to define with considerable particularity the considerations which were to be part and parcel of a determination of the third requirement for patentability.[9] Second, the nonobvious test of Section 103 was to be used to determine patentability instead of the subjective "invention" test of earlier years. This second point is demonstrated by the fact that the term *invention* is used in the 1952 Patent Act only to identify the thing discovered, devised or created, and not to measure the patentability of a new product, apparatus or process. Although the exact meaning of *invention* does vary,[10] nowhere in the Act is there any reference to a requirement of "invention." Indeed, as Judge Rich, one of the draftsmen of the 1952 Act, made clear even before the *Trilogy* was decided, "the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term. . . ."[11]

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[8] 35 U.S.C. 103 (1964).

[9] Even before the *Trilogy*, some courts recognized this fact. See the discussion in Note: *After Black Rock: New Tests of Patentability–The Old Tests of Invention*, 39 Geo. Wash. L. Rev. 123, 139 *et seq.* (1970); writers were aware of it, e.g., see Note, *The Standard of Patentability–Judicial Interpretation of Section 103 of the Patent Act*, 63 Colum. L. Rev. 306 (1963); and the House Committee Report on the bill, which ultimately became the Patent Act of 1952, reflected the fact that Section 103 was a major innovation of the bill "to revise and codify the laws relating to patents," see S. Rep. No. 1979, 82d Cong., 2d Sess. 1, 88 (1952).

[10] See Janicke, The Varied Meanings of "Invention" in Patent Practice: Different Meanings in Different Situations, 2 Pat. L. Persp. (1971).

[11] Rich, "Congressional Intent–Or, who Wrote the Patent Act of 1952", in *Patent Procurement and Exploitation* 61, 70 (B.N.A. 1963).

C. The Trilogy

This Court's decisions in the *Trilogy* are entirely consistent with the foregoing comments on the legislative intent with respect to the 1952 Act and Section 103. In all three of the cases which make up the *Trilogy*, this Court focused on the requirements of Section 103. In *Graham* and *Calmar*, the ground rules were established:

> "[T]he § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of 'Nonobviousness,' 112 U. Pa. L. Rev. 1169 (1964).[12]"

While it has been suggested following the *Trilogy* that it was the *differences* between the subject matter sought to be patented and the prior art that had to be unobvious, rather than the subject matter as a whole,[13] and that the so-called secondary considerations were not to be used unless obviousness was in doubt,[14] the application of the *Trilogy*

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[12]383 U.S. at 17-18.

[13]The author of the *Trilogy*, Justice Clark, scotched this effort to restrict the holding when he sat on the Court of Customs and Patent Appeals by designation. In *In re Wiggins*, 397 F.2d 356 (C.C.P.A. 1968), he pointed out that the Court had meant that the "subject matter as a whole" had to be nonobvious, just as section 103 specified. See also Palmer v. United States, 390 F.2d 1006 (Ct. Cl. 1968).

[14]See, e.g. Proler Steel Corp. v. Luria Bros., 417 F.2d 272 (9th Cir. 1969). *But see* Sylvania Electric Products Co. v. Columbia Broadcasting System, 415 F.2d 719 (1st Cir. 1969).

test to the factual setting of the *Adams* case leaves no doubt but that such distinguishing forays are in error. Moreover, they are illogical and inconsistent with the purpose behind the nonobviousness test of Section 103.

It will be recalled that the Adams' invention was a constant current, nonrechargeable battery which used water as an electrolyte. The structure claimed in the Adams patent was quite similar physically and chemically to the prior art although it was not directly anticipated under 35 U.S.C. 102. The Adams battery used electrodes of cuprous chloride and magnesium and, while electrodes of these materials had not been used in the same battery, zinc and silver chloride electrodes had been and the prior art taught the equivalency of cuprous chloride and silver chloride electrodes and magnesium and zinc electrodes. Had this Court restricted its consideration to the small structural changes which distinguished the Adams battery from prior art batteries, the inventor would have undoubtedly been out of luck. Instead, the differences were examined in the context of the subject matter as a whole, the level of ordinary skill in the pertinent art, the unexpected properties of the combination and the dramatic secondary factors of commercial success, long-felt need and other forms of objective evidence.

The finding of validity in *Adams* properly underscores the fact that courts must marshal *all the evidence* before deciding whether a particular invention is obvious or nonobvious. In a given technology, a small structural change may portend a monumental new discovery, whereas large structural differences may only evidence a Rube Goldberg approach to a simple problem. Whether the differences make the "subject matter as a whole" obvious or nonobvious depends, for example, on the results obtained, the level of skill and sophistication in the art, the problems the art has solved and has tried to solve. To decide into which category a new invention fits, the Patent Office and the courts must look at *all* the evidence available on these questions just as the triers of fact

in any case must look to *all* the evidence in deciding disputed issues and their legal consequences.[15] The determination that an invention is obvious or nonobvious is a legal conclusion but it must necessarily be based on the factual inquiries this Court so cogently enumerated in the *Trilogy*.

The secondary considerations are secondary in time only. As evidence they are necessarily not only primary but the only evidence that can be derived on the issue of what is obvious to a person of ordinary skill in the art. Judge Learned Hand emphasized this fact on a number of occasions even before the 1952 Patent Act was passed. For example, in *Safety Car Heating and Lighting Co. v. General Electric Co.*[16] Judge Hand made the following observations in discussing how courts should approach the appraisal of an inventor's contribution:

> "In appraising an inventor's contribution to the art, as we have often said, the most reliable test is to look at the situation before and after it appears. Substantially all inventions are for the combination of old elements; what counts is the selection, out of

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[15]The recent Note on *Black Rock*, which is reprinted in the Appendix for the convenience of the Court, aptly describes the nature of the secondary considerations as follows:

> "These evidentiary considerations are "secondary" in the sense that they occupy a different level in the hierarchy of legal and factual conclusions. Obviousness is the ultimate issue; the claimed invention, prior art and level of skill in the pertinent art, and difference between the prior art and claimed invention as compared to the level of skill in the art are all sub-issues preliminary to the determination of obviousness. To resolve the crucial sub-issues a court entertains factual evidence such as the claims, specification and file history of the patent, prior patents, publications and testimony of those skilled in the art *and* any other facts such as commercial success and long-felt need."

Note, After *Black Rock: New Tests of Patentability—The Old Tests Of Invention*, 39 The Geo. Wash. L. Rev. at 142 n. 127 (1970).

[16]155 F.2d 937 (2d Cir. 1946).

> all their possible permutations, of that new combination which will be serviceable. No objective standard is practicable; . . . as, for example, whether each of the elements operates in a different way from what it did in other combinations. That is almost never true of a machine; each member ordinarily performs the same mechanical function which it does in any other machine; it is their cooperation that produces the result, and the value of that cooperation depends upon the sagacity which divined the end and fabricated the means. Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions."[17]

In many ways the problem is similar to situations when so-called "structurally obvious" compounds, i.e., different but very similar structurally, are sought to be protected. It was asserted before the Court of Appeals for the District of Columbia in *Commr. Patents v. Deutsche Gold-und-Silver-Scheideanstalt Vormals Roessler*[18] that the *Trilogy* demanded that once an invention was determined to be "structurally obvious" that was the end of the matter. The court in a clearly reasoned opinion rejected this argument. The unex-

[17] *Id.* at 939.

[18] 397 F.2d 656 (D.C. Cir. 1968).

pected properties of the new compound rendered the invention patentable. The results counted and warranted patent protection for even a compound so structurally similar as to be prima facie obvious. Closeness structurally to the prior art can never tell the whole story on obviousness. For example, in the *Eibel Process* case,[19] the improvement in the Fourdrinier machine was really made when the reason for the limitation on the speed of the existing machine was understood. Raising one end of the machine some fifteen inches with respect to the other end was a *small* change but it permitted a major increase in speed to be attained. But a bare bones approach to this change in the machine's orientation would have never revealed the inventor's genius.

D. *Black Rock, the "Invention" Test and Combinations*

In *Black Rock,* the court held the combination patent apparatus for laying continuous black-top paving invalid because it failed to meet the test of "invention":

> "Each of the elements combined in the patent was known in the prior art. . . .
>
> "The combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a 'new or different function,' *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, within the test of validity of combination patents. . . .
>
> "We conclude that while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented. We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Use of the radiant burner in this important field marked a successful venture. But as noted, more than that is needed for invention."[20]

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[19] Eibel Process Co. v. Minnesota & Ontario Paper Co., 216 U.S. 45 (1923).

[20] 396 U.S. at 59, 60, 62-63.

The Court elaborated on its finding of invalidity by stating:

> "A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But these matters 'without invention will not make patentability.' *A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153."[21]

The juxtaposition of these statements in *Black Rock* raises two basic problems:

(1) what happens to the obvious-nonobvious standard when a combination invention is present?

(2) what effect does the "invention" test of patentability have on the "secondary considerations" which figured so heavily in the *Trilogy*.

The ensuing discussion will treat each of these problems in order.

1. *Combination Inventions and the Obvious-Nonobvious Standard*

Given only the foregoing excerpts from *Black Rock* which contain only the briefest reference to the obvious-nonobvious standard, it would seem that the nonobvious test was no more. But the Court's opinion goes on to repeat the *Trilogy* criteria for determining nonobviousness and proclaims that "We admonish that 'strict observance' of those requirements is necessary."[22]

While the *Trilogy* test and the "invention" test of *Black Rock* might be reconciled in theory, in practical effect the reconciliation is not that at all but a determination that the "invention" test is the super test which is always applied.[23] How does this come to pass?

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[21] *Id.* at 61.

[22] *Id.* at 62.

[23] See *The Crisis of Law in Patents*, supra note 4 in Pt. I, 8.

If the tests are to be mutually compatible, then the *Trilogy* criteria for nonobviousness is always applicable and operative while the *A & P* test[23a] only comes into play and is superposed on those criteria when the invention happens to be a combination of old elements. Under these circumstances, the following questions will have to be answered before patentability may be decided with respect to any particular invention even though it is admittedly new and useful:

(a) Is a combination of old elements really present?

(b) If so, does the combination of old elements produce a "new or different *function*" (not merely a new, different or unexpected *result*)?

(c) *How* new, *how* unexpected, *how* different, *how* much synergism must exist in a combination of old elements case as contrasted with patentable inventions which are not combinations of old elements?

Considering these in turn, when do we have a combination of old elements calling into play the super-standard overshadowing the *Trilogy?* The question can be more realistically dealt with by rephrasing it. When is an invention, any invention, *not* a combination of old elements, or in the case of a process, a combination of old steps?

The answer is *never.* Scientists and engineers (and artists as well), no matter how brilliant, do not create without using elements, components, materials, symbols or techniques that are known. Even Dr. Seaborg's invention of the trans-uranium elements,[24] curium and americum, involved combinations of old or known elements—protons, electrons and the like.

No one has put it better than Judge Learned Hand, who was a most articulate and thoughtful commentator on the

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[23a]Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950).

[24]*See In re* Seaborg, 328 F.2d 993, 996 (C.C.P.A. 1964).

law of patents, and Professor C. E. Ayres, who has devoted a lifetime to the study of inventions and discoveries and their economic consequences. Judge Hand made the point in a number of cases, including the *Safety Car Heating* decision which was previously quoted and *Reiner v. I. Leon Co.*[25] In *Reiner*, which is cited with approval in *Graham*, he stated:

> "It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination'; that is to say, it consists of former elements in a new assemblage."

Dr. Ayres made the same point in somewhat greater detail and from another point of view:

> ". . .there is no difference between 'mechanical' invention and 'scientific' discovery. Scientific discoveries also result from the combination of previously existing devices and materials, laboratory instruments and techniques. It was by combining a magnet with a Crookes tube, for example, that J. J. Thomason discovered that the stream of incandescence in the tube was in fact a stream of physical particles and was even able to calculate the mass of the electrons. It was by combining a prism with a telescope that astronomers were able to identify elements (such as helium) in the sun. Even in the fine Arts 'creation' comes about in the same way. Leonardo's great achievement illustrated by the famous Mona Lisa . . . was that he applied techniques which the monks had devised for the portrayal of angels to the portraiture of living subjects. Cezanne characterized his achievement as resulting from the application of Pissarro's studio technique to painting from nature. In every innovation analysis reveals the combination of previously existing devices. That is what the

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[25]285 F.2d 501, 503 (2d Cir. 1960), *cert. denied*, 366 U.S. 929 (1961).

> achievement is which in different fields we call invention or discovery or creation."[26]

The fact of the matter is that all inventions are combinations, the elements necessarily having been the building blocks at hand.

Where a new combination includes an element that is itself nonobvious, that element is subject to independent and separate patent protection. Given such patent protection for the element, that element's novelty cannot be the sole basis for patentability of the combination in which it resides.[27] For example, in *Black Rock*, the novelty of the radiant burner element was properly held to lend nothing to the patentability of the overall combination in which it was claimed. To hold otherwise would result in a grant of patent protection in two different patents for the very same contribution, a condition expressly rejected by the doctrines of double-patenting and that of an old or exhausted combination when the *combination* itself fails to be novel.

[26]C.E. Ayres, *The Theory of Economic Progress* 115 (University of North Carolina Press, Chapel Hill (1944)). Ayres also made the same point in *The Problem of Economic Order* 13 (Farrar & Rinehart, Inc. New York (1938)), as follows:

> "Whatever the ingenuity of the individual inventor, an invention always results from the combination of pre-existing mechanical contrivances. No chemist, however brilliant, could bring about a given chemical reaction if the substances of which it is the reaction did not exist, and no mechanical genius could apply the vacuum tube to wireless telephony if neither telephony nor wireless telegraphy nor vacuum tubes had been developed."

[27]This was, in part, the situation in Lincoln Engineering Co. v. Stewart Warner Corp., 303 U.S. 545 (1938). The apparatus in question was used to lubricate automobile bearings. The patentee made *two* inventions although the Court believed there was only one invention present. The Court assumed *arguendo* that that one invention—the coupling member for the apparatus—was patentable and used that fact to hold the patent claiming the combination of the pump, hose, fitting and coupling member invalid for some sort of misclaiming.

In current parlance, the combination was clearly an *invention* in the sense the term is used in the 1952 Act and so was the coupling

If the *A & P* test and the *Trilogy* test are to coexist and be considered in *pari materia*, the superimposed criteria of *A & P* will always be operative until someone can persuade through sophistry that a particular invention is not a combination of old elements or steps. The *A & P* test dominates the *Trilogy* in every case, and indeed, courts have said as much.[28] If they are not reading *A & P*, the *Trilogy* and *Black Rock* as this Court intended, they should be so advised or the instructions clarified.

The second issue raised by *Black Rock*, namely, does the combination produce a new or different *function*, appears from the *Black Rock* language to be distinguished from the production of a new or different *result*. The latter, of course, is a significant factor in determining nonobviousness as the Court effectively demonstrated in *Adams*. It was the totally new and different *result* produced by the Adams battery that led the Court to hold it patentably nonobvious despite the fact that each element of the battery (every one of which was old) functioned in exactly the same way as it did in the prior art. Indeed, the government's attack on nonobviousness attempted to exclude the new and different nature of the *result* and focused exclusively on the

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member. Whether the combination was a patentable invention as measured by Section 103 and the *Trilogy* criteria was a different matter.

[28]In this sense, the Sixth Circuit got the message and so expressed it in Minnesota Mining & Mfg. Co. v. Norton Co., ___ F.2d ___, 165 U.S.P.Q. 755 (6th Cir. 1970):

"In 1952 Congress added § 103 to the patent law so as to give statutory recognition of that 'impalpable something' which the courts had long required for 'invention.' . . .

"The Supreme Court command in Great A & P Tea Co. v. Supermarket Equipment Co. . . . still may be the clearest indication of the proper nature of our appellate review: . . . '[I]t is the standard of invention that controls.' . . .

"In Section 103, Congress has merely outlined a somewhat functional inquiry into 'obviousness' as opposed to 'invention.'"

fact that each element was known and each functioned as taught by the prior art. The combination, *the invention as a whole,* was responsible for the startling result. *Black Rock,* however, reinstitutes the possibility that unanticipated results, disbelieved and taught away from by experts in the art, do not make for patentability unless the elements *function* in a new way, a result antithetical to the holding in *Adams.*

The last consideration is, how much synergism is necessary? In *Adams,* a sufficiently new and different result was found but no so in *Graham* and *Calmar* where the results were new and different but apparently not sufficiently so. Perhaps they did not push back the frontiers of science as the concurring opinion in *A & P* suggested was necessary, although many had thought this proposition had been tacitly rejected in the *Manson*[29] case requirement of "practical" utility.

2. *Effect of "Invention" Test on Secondary Considerations*

The effect of the *Black Rock* formulation of the *Lincoln Engineering-A & P* "invention" test on the so-called secondary considerations is quite clear from the language used: "But those matters 'without invention will not make patentability.' "[30]

As the discussion in the previous section makes abundantly clear, it is not possible to determine nonobviousness without looking at these secondary considerations. They are the *primary evidence* on what the level of ordinary skill in the art is. Without them, a court is operating in an absolute vacuum in trying to *divine* whether an invention is obvious or nonobvious. Surely, this approach to the complexity of patent validity questions can have only dire

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[29]Manson v. Brenner, 383 U.S. 519 (1966).

[30]396 U.S. at 61.

consequences for the patent system and perhaps even more importantly for the public confidence in our courts.

Increasingly, the objective or secondary considerations of nonobviousness raised by the *Trilogy* are not considered at all if the prior art and the claimed invention are determined to be structurally quite similar and thus, in a sense, *prima facie* obvious.[31] Unless all the evidence, including the objective evidence dealing with factors such as long felt need in the art, unsuccessful attempts by those skilled and expert in the art to solve the problem, commercial success, extensive licensing, prompt and immediate copying, is considered in the determination of validity, we are thrust back to the precise situation which called Section 103 of the 1952 statute into being, without regard to the full and painful legal history of how the subjective standard of "invention" and its shifting burden was replaced by a reasonably objective standard of patentability.

E. THE BLONDER-TONGUE–FOUNDATION CONTROVERSY

It is significant that the courts in the Seventh Circuit below and in the Eighth Circuit in *Winegard* all sought to use Section 103 and the *Trilogy* criteria to ascertain the patentability of both the Isbell and Blonder-Tongue patents. It is noteworthy that none of the four courts involved even cited *Lincoln Engineering* or *A & P* even though the patented antennas are clearly combinations of old elements. It does demonstrate, however, that so called combination inventions can be treated under the criteria laid down in the *Trilogy* without reference to *Lincoln Engineering* or *A & P*.

None of the courts nor the parties seriously questioned the fact that all the elements of the Isbell antenna were disclosed in various parts of the prior art. Even the district

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[31] See survey of the post–*Black Rock* decisions in Pat. L. Persp. § A.1[1] (1969-70 Annual Review).

court in the Eighth Circuit, which held the Isbell patent invalid as obvious, characterized Isbell's frequency independent unidirectional antenna as a *combination* of "the dipole array of Katzin with the transposed feeder line of the Channel Master 'K.O.' or the Koosman or Winegard Patents. . . . adjusted by the log periodic theory of antenna design. . . ." (Appendix 111) The district court in the Seventh Circuit agreed and further observed:

> "In order to defeat a meritorious patent it is not enough 'to pick out isolated features' in the prior art, 'combine them in one particular way with hindsight acquired only from the patent under attack, and then say that no invention would have been involved in selecting those particular features and combining them in the particular way in which the patentee did.' *Eversharp, Inc. v. Fisher Pen Co., Inc.*, 204 F.Supp. 649, 662-63 (N.D. Ill. 1961)." [Appendix 78]

The district court below thus looked to all three factual inquiries of the *Trilogy* as well as the "secondary considerations." (Appendix 78) The Eighth Circuit in *Winegard* listed the inquiries under the *Trilogy* to be the "(1) scope and content of the prior art, (2) differences between the subject patent and the prior art, (3) the level of the skill in the art at the time involved and (4) secondary considerations relating to commercial success, long-felt need, et al." It pointed out immediately thereafter that "of course, the latter factors cannot alone determine patentability." (Appendix 96)

The problem with this exclusionary judgment is that a court cannot fully understand "the level of the skill in the art at the time involved" and, to a lesser extent, "the scope and content of the prior art," unless it examines these secondary considerations which provide the primary evidence. Just as courts receive parole evidence to understand the intent of the parties to a contract or the meaning of its terms, so must courts look to the secondary considerations outlined in the *Trilogy*.

While it appears that neither court of appeals automatically closed its collective eye to secondary considerations, these considerations need to be brought out from under the table and considered as the principal factual inquiry dictated by Section 103. Unless this is done, lower courts will be prone to ignore the secondary considerations altogether—or at least ignore them until the first three inquiries are determined with the hindsight borne of having the patentee's teaching and organization in front of them. At that point, it may be too late to derive the full impact and importance from the so-called "secondary considerations," without which an objective evaluation of the level of ordinary skill cannot be made.

Amicus curiae is not proposing that any one of the factual inquiries should be controlling, let alone the secondary considerations. It is the sum total of the *Trilogy* criteria that should be the basis for a court's legal conclusion as to nonobviousness. Anything short of this puts a premium on reaching a decision—often involving highly complex technology—on an incomplete and therefore inadequate record.

Indeed, the different records before the trial courts in the Seventh and Eighth Circuits below, consisting largely of the testimony of Dr. DuHamel and Mr. Blonder and the DuHamel patent, illustrate the point. Had the courts of the Eighth Circuit had before them all the prior art along with these flesh and blood judgments of persons involved in antenna technology, they might have agreed with the Seventh Circuit that the patent was valid. For, after all, it is the level of ordinary skill *in the art*, not that of judges having the hindsight of Monday morning quarterbacks, that is the standard.

If all such evidence is received and considered together *before* reaching a legal judgment on nonobviousness, it promises to shed the most light on how the predictability issue, which loomed large in the Eighth Circuit's opinion in *Winegard*, fits into the present picture. There the Court observed that "where logical exploration within known principles of science achieves an unpredictable result . . .,

the burden of nonobviousness is not necessarily overcome." (Appendix 96)

Routine experimentation may make the outcome "obvious" depending upon what the prior art teaches or suggests. The level of experimentation which can properly be described as routine depends vary largely on the level of skill in the art and even on what adepts in the art consider routine. While DuHamel's or Blonder's testimony may not be conclusive, it is indeed material to an understanding of what "routine" means to a person skilled in the pertinent antenna art.

The argument that it is "obvious to try" and therefore obvious is a dangerous one. As the court in *In re Tomlinson.*[32] aptly pointed out:

> "[T]he question . . . is obviousness under section 103 of *compositions* and *methods*, not of the direction to be taken in making *efforts* or *attempts.* Slight reflection suggests, we think, that there is usually an element of 'obviousness to try' in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and that patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research.'"

The critical question is really whether the result obtained or the reason for the routine experimentation is so completely taught or suggested by the prior art that a person having ordinary skill in the art would get the message. If so, the patent is invalid. If not, the nonobviousness condition of patentability is met. The best judgment on this issue can be reached only by considering all the evidence which bears on the subject.

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[32]363 F.2d 928, 931 (C.C.P.A. 1966).

V. THE TRIPLETT V. LOWELL QUESTION

A. Introduction

The American Patent Law Association does not view the *Triplett v. Lowell*[33] question as one which has a side of the angels and a side of the demons. Nor is it a question on which the interests of inventors lie wholly with the side urging "no retreat" from the stark rigor of Mr. Justice Stone's words in his 1936 *Triplett v. Lowell* opinion:

> "Neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant".

On the other hand, the solution of "*in rem* invalidity" advanced by the President's Commission[34] is unrealistically Draconian in the other direction. Including the instant case, there have been no less than six patents first held invalid by one court and then found valid by another since 1954. Clearly, reasonable men (Federal judges) can differ about the sufficiency of a given state of facts to invalidate a patent; to give "sudden death" standing to a single holding of *in*validity may very well, therefore, be a denial of justice to a worthy inventor.

The American Patent Law Association is deeply concerned with the efficacy of the patent laws to accomplish their constitutional purpose,[35] namely, "to promote the progress of***useful arts." If litigation to enforce patent rights is protracted, expensive, burdensome, and unwieldy, something is amiss with those laws, at least procedurally. If to such faults is added that of uncontrolled relitigation, the reputation of the patent system itself suffers. However, to sub-

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[33]297 U.S. 638 (1936).

[34]*Report of the President's Commission on the Patent System* (Washington, D.C., 1966) 44.

[35]Graham v. John Deere Co., 383 U.S. 1 (1966).

stitute for the latitude of *Triplett v. Lowell* the full rigor of collateral estoppel as urged by the proponents of *in rem* invalidity is to work a grave injustice in many cases both on patentees and on the system by the Procrustean expedient of fitting the sleeper to the bed.

The conclusion which the American Patent Law Association draws from its examination of the problem is this:

The Supreme Court should not overrule *Triplett v. Lowell* in the instant, or any other case, but it should urge upon the Congress the prompt consideration of legislation dealing with patent litigation to the end that a patentee can be assured of a full and fair opportunity in a single plenary proceeding to achieve, if he prevails, a victory commensurate in economic value with the loss he would suffer, if defeated. While awaiting legislative resolution of all the complexities of the problem of restructuring a just and complete system for efficient patent enforcement, the Supreme Court should give its explicit support to the use by the lower Federal courts of existing devices available to them for the summary disposition of, and the imposition of full-compensatory recovery of litigation expenses in, cases where a patent once finally held invalid is unjustifiably relitigated.

B. The Forum Shopping Problem

The heart of the objection to the application of rigorous collateral estoppel to the relitigation of an issue of patent validity is unfairness to a patentee stemming not from the old mechanistic notion of "mutuality," but from the non-uniformity with which the trial courts and lower appellate courts treat that issue. As this Court well knows, there is no litigant so alert to the advantages flowing from the choice of venue as a patent litigant with the possible exception of a personal injury plaintiff on the trail of a big city verdict. The reason for this is well known, too. There simply is not a nationally applied standard of patentability in terms of a uniform concrete application by the lower Federal courts of the verbal formulae taken from recent opinions of this Court to the fact situations of actual patents.

The response of patentees and putative infringers to this situation is, of course, forum shopping, both active and passive. Thus, a patent owner may create a patent holding corporation in a validity jurisdiction in order to limit venue of declaratory judgment actions attacking the validity of the patent to that jurisdiction. Or a patent owner suing a widespread infringer will select the most validity-minded of the available jurisdictions, regardless of convenience considerations, and seek by judicious joinder of codefendants to thwart a transfer to a more convenient, but invalidity-minded forum. A patent owner who has not taken precautionary measures and who undertakes a licensing campaign thereby courts a declaratory judgment action brought by the most minor league of the putative infringers in the most antipatent jurisdiction in which the patentee can be brought to bar.

The decisions of this Court have weighted the odds in the forum "derby" rather severely against the patentee in that the restrictively-interpreted 28 U.S.C. § 1400(b) severly limits the patentee-plaintiff's choice of forum in an infringement action,[36] while the liberally-interpreted 28 U.S.C. § 1391 gives the declaratory-judgment plaintiff[37] seeking to establish invalidity the widest range.

It seems clear that mere reversal of *Triplett v. Lowell* can only intensify this forum shopping by further increasing the stakes a patent owner has at hazard. Moreover, it would further heighten the odds against him.

C. The So-Called Burden of Multiple Patent Litigation is Exaggerated

In these days of crowded dockets, it is impossible not to sympathize with a desire to give each litigant his day in court, *but only one such "day"* on a given issue. Obviously,

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[36]Fourco Glass Co. v. Transmirra Products Corp., 353 U.S. 222 (1957).

[37]General Tire & Rubber Co. v. Watkins, 326 F.2d 960 (4th Cir. 1964), *cert. denied* 377 U.S. 909 (1964).

the justice of such a result depends on the courts involved being completely free of outcome-predictability "bias", else one "day" is in no sense the equivalent of some other "day".

We have already noted that, although patent law has been a purely national matter since 1789, there is not in 1970 even a freedom from outcome-predictability "bias" in the Federal courts sufficient to give an approximation of national uniformity in patent law enforcement. For this reason, *Triplett v. Lowell* has been felt by inventors to be their best assurance of a chance of getting a national standard applied to the testing of the validity of their patents through review by this Court of conflicting decisions should they have the bad luck to encounter an antipatent tribunal on the first try.

There has been a Senate study[38] of patent litigation satistics. It reports for the period 1949-1958 that 80% of patents litigated were litigated only once and an annual average of only 2.7 patents were relitigated following an adverse holding on validity. The American Patent Law Association has not verified the up-dating information that over the period 1954-1970 there were only 23 relitigations of a patent once held invalid, but it has no reason to doubt the substantial accuracy of the figure. This shows a more recent yearly average of less than 2 relitigated cases that would be eliminated by reversal of *Triplett v. Lowell* and the adoption of rigorous *in rem* invalidity.

D. Some Legislative Options

Triplett v. Lowell was decided in 1936. In 1952, the patent laws were recodified, and to some extent revised, and enacted into positive law as Title 35, United States Code. No change was made by the Congress in the *Triplett v. Lowell* doctrine.

[38] An Analysis of Patent Litigation Statistics, Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate (Washington, D.C., GPO 1961).

By 1966, a need felt in some quarters for further modernization of the patent laws resulted in the Report of the President's Commission, *supra*. In that report, a complete reversal of *Triplett v. Lowell* by legislation was proposed and a bill[39] was introduced in the First Session of the 90th Congress by the Administration proposing as § 294 of a new Title 35, in pertinent part:

> "In any action in a Federal court***a final adjudication***limiting the scope of the claim or holding it to be invalid, shall constitute an estoppel against the patentee***in any subsequent Federal action***."[40]

After the appearance of S.1042, there was a flurry of activity and a number of other "patent reform" bills were introduced and rather extensive hearings were held in both Houses. No legislation has been adopted yet, but it is noteworthy that the latest "McClellan" bill, S.2756, introduced into the 91st Congress, First Session, contains *no* provisions on estoppel, thus manifesting a conscious decision on the part of Senator McClellan, Chairman of the Subcommittee, to leave *Triplett v. Lowell* untouched.

Certain proposals that have been made over the years which Congress could and should weigh carefully are set out below. The American Patent Law Association, in calling these possible alternatives to the all-or-nothing dichotomy of *Triplett v. Lowell* versus *in rem* invalidity, espouses none of them. Our purpose is merely to demonstrate the soundness of our suggestion that restructuring of patent litigation, including any restraint found appropriate on relitigation not already provided by rule or statute, is best handled by the

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[39]S.1042 (McClellan) 90th Cong., 1st Sess. (1967).

[40]It may be observed in passing that the recent prominence given (in Lear, Inc. v. Adkins, 395 U.S. 653 (1969)) to State adjudication of the *issue* of patent validity in the context of some cause of action other than patent infringement even raises some doubt about the completeness of the solution proposed.

comprehensive legislation process. In the meanwhile, proper consideration for *stare decisis* suggests that this Court join the lower Federal courts[41] in leaving *Triplett v. Lowell* alone.

Since the older doctrine of "mutuality" probably had its origins in the sporting theory of justice[42] there is no reason to insist on its retention uniquely in patent litigation, but real considerations of down-to-earth fairness require that the rule of *Triplett v. Lowell* be replaced by some other approach than *in rem* invalidity. Some of these considerations and proposals to accommodate them are:

1. Particularly in patent cases, for reasons already noted, choice of forum is a serious consideration. Further, as dramatically shown by the decision of this Court in *Adams*, a determination of validity may be decisively influenced by the actual impact of the invention on the practices of the of the Art. Thus a different rule of estoppel could appropriately be applied in cases where a patent is held invalid in an action begun by a patentee at a time chosen by him in a forum chosen by him, from that applied in declaratory judgment actions brought against him and reaching the same result.

2. The artificially restricted venue rule [28 U.S.C. § 1400 (b)] applicable to patent infringement actions makes it difficult for a patentee to join all suspected infringers in a single action.[43] Since there are public policy reasons for permitting

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[41]Nickerson v. Kutschera, 419 F.2d 983 (3rd Cir. 1969); Blumcraft of Pittsburgh v. Kawneer Co., ___ F.Supp. ___, 166 U.S.P.Q. 265 (N.D. Ga. 1970) [petition to appeal denied August 20, 1970 by the Court of Appeals for the Fifth Circuit and denial reaffirmed by that court *en banc* September 18, 1970].

[42]*See* Bruzewski v. United States, 181 F.2d 419 (3rd Cir. 1950), *cert. denied*, 340 U.S. 865 (1950).

[43]The restrictive venue policy of 28 U.S.C. § 1400(b), as construed by this Court, was held to place a crippling limitation on the availability of the class action device (Rule 23, Fed.R.Civ.P.) to patentees in Technitrol, Inc. v. Control Data Corp., ___ F.Supp. ___, 164 U.S.P.Q. 552 (D.Md. 1970).

successive putative infringers to contest patent validity, thus preventing any estoppel creating *in rem* validity, a great deal of the possible unfairness to patentees would be eliminated if liberal venue provisions such as those applicable in anti-trust actions were adopted. Such relaxation would enable a patentee to have one big action in which he could obtain judgment against substantially all infringers, thus eliminating his present necessity of suing *seriatim*, with consequent savings in judicial time, and leaving him no just ground for complaint at being estopped to bring a second suit if his patent were held invalid.

3. An assistance toward national uniformity of patent validity doctrine in actual application might be found in legislation assigning to the Patent Office some *amicus* role in litigation in which the validity of a patent was an issue.

4. Alternatively, the creation of a single court of patent appeals has been proposed to serve the unifying role this Court filled before the creation of the Circuit Courts of Appeals.

No sufficient justification has been shown for reversal of *Triplett v. Lowell.* The complexities of the problem involved demand a legislative solution to prevent the creation of new evils. Only an integrated restructuring of patent litigation can provide at one and the same time for protection against waste of judicial effort, fairness to patentees, and protection against oppressive reassertion of void patents.

VI. CONCLUSION

From the foregoing discussion, *amicus'* prayer to this Court can be stated briefly:

(1) Reaffirm that Section 103 as interpreted in the *Trilogy* is the only standard for determining the patentability of new contributions to the useful arts;

(2) Declare that since all inventions are combinations of old elements, all inventions are to be subjected to the same standard of patentability;

(3) Prescribe that under the *Trilogy* criteria, the so-called "secondary considerations" must be included as an integral part of the evidence to be reviewed prior to determination of the obviousness issue; and

(4) Adhere to *Triplett v. Lowell* so that the Congress can restructure patent litigation with due regard to all the interests involved.

Respectfully submitted,

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